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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

MCADAMS, BRAD

ART UNIT

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2456

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/501,944	POIKSELKA ET AL.	
	Examiner	Art Unit	
	ROBERT B. MCADAMS	2456	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/1/2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 1-20,32-41,43 and 45 is/are pending in the application.
- 5a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 6) ☐ Claim(s) ____ is/are allowed.
- 7) ☒ Claim(s) 1-20,32-41,43 and 45 is/are rejected.
- 8) ☐ Claim(s) ____ is/are objected to.
- 9) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. This Office Action is in response to the amendment filed on November 1, 2010.
2. Claims 1-20, 32-41, 43 and 45 are pending.

Response to Arguments

3. Applicant's amendments, filed 11/1/2010, with respect to Claim 45 have been fully considered and are persuasive. The 35 USC 101 rejection of Claim 45 has been withdrawn.

4. Applicant's arguments, see pages 12-22, filed 11/1/2010, with respect to the rejections of claims 1-20, 32-41, 43 and 45 under 35 U.S.C. 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new grounds of rejection is made in view of *Morin in view of Clapton*.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1-4, 9-18, 32, 37, 40-41 and 45** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Morin* (U.S. Patent No. 6,584,312) in view of *Clapton* (U.S. Patent No. 6,556,823).

7. As to **Claims 1, 32, 37, 40 and 45**, *Morin* discloses detecting a change in said subscription information of said subscriber (**Changes to mobile station subscription information are detected and a profile request message 310 is initiated. Column 4, Lines 35-46**);

checking whether a capability of a network element serving a terminal device of said subscriber is still in accordance with said changed subscription information (**The subscriber profile is compared to the MSC capabilities to check for compatibility. Column 4, Lines 35-55**); and

However, *Morin* does not expressly disclose initiating a registration procedure to a new serving network element that is in accordance with said changed subscription information.

Clapton, in the same field of endeavor, teaches initiating, in response to the result of said checking being that said capability of said network element serving said terminal device of said subscriber is not still in accordance with said changed subscription information, a registration procedure for registering said terminal device of said subscriber to a new serving network element that is in accordance with said changed subscription information (***Clapton* gives the example of when a mobile user roams to a new network, the Mobile Switching Centre 3-1 will not recognize**

subscription feature (a voicemail box feature) of said mobile user, so said mobile user is registered to the home network's Mobile Service Control Point 1-6 which is able to provide the necessary information to provide the subscribed voicemail box features. Column 8, Lines 5-47).

At the time of invention it would have been obvious to a person of ordinary skill in the art to have combined the subscriber registration method as taught by *Morin* with registering a terminal device to a new network element that supports subscription information as taught by *Clapton*. The motivation would have been to allow the terminal device to use additional subscription information features in a different environment.

As to **Claim 2**, *Morin-Clapton* teach the subscriber registration method as previously discussed in Claim 1. *Morin* further teaches wherein said checking comprises checking whether said serving network element is still capable of serving said terminal device of said subscriber based on said changed subscription information **(The subscriber profile is compared to the MSC capabilities to check for compatibility. Column 4, Lines 35-55).**

As to **Claim 3**, *Morin-Clapton* teach the subscriber registration method as previously discussed in Claim 1. *Morin* further teaches wherein said detecting is based on a detection of a subscriber profile update **(Column 4, Lines 43-46).**

As to **Claim 4**, *Morin-Clapton* teach the subscriber registration method as previously discussed in Claim 1. *Morin* further teaches wherein said detecting is based on a detection of a subscription of said subscriber to a new service. **(Mobile user registers to a new service, updating subscription. Column 4, Lines 35-46)**

As to **Claims 9 and 10**, *Morin-Clapton* teach the subscriber registration method as previously discussed in Claim 1. *Morin* further teaches wherein said checking step comprises the steps of transmitting a capability query comprising an information indicating at least one required capability to said serving network element; comparing capabilities of said serving network element with said information about said at least one required capabilities and receiving an acknowledgment indicating the result of said comparing step from said serving network element **(The MSC capabilities are received and the subscriber profile is compared to said MSC capabilities to check for compatibility. Column 4, Lines 35-55).**

As to **Claim 11**, *Morin-Clapton* teach the subscriber registration method as previously discussed in Claim 9. *Clapton* further teaches sending a de-register message for de-registering said terminal device to said serving network element in response to the received result **(Upon denial of a subscription service, MSC 3-1 de-registers the mobile user. Column 8, Lines 22-41).**

As to **Claim 12**, *Morin-Clapton* teach the subscriber registration method as previously discussed in Claim 11. *Clapton* further teaches wherein a re-registration procedure is initiated by said terminal device in response to a message issued by said serving network element **(The mobile user re-registers with the home MSC 1-6. Column 8, Lines 22-41).**

As to **Claim 13**, *Morin-Clapton* teach the subscriber registration method as previously discussed in Claim 11. *Morin* further teaches wherein said de-register message comprises a cause information configured to indicate that the reason for de-registration was need for changing said subscriber information **(A message is sent to the mobile user indicating why the subscription profile was changed. Column 4, Lines 58-67).**

As to **Claim 14**, *Morin-Clapton* teach the subscriber registration method as previously discussed in Claim 13. *Clapton* further teaches wherein said cause information is used by said terminal device to detect that a re-registration is required **(Column 4, Lines 58-67).**

As to **Claims 15, 18 and 34**, *Morin-Clapton* teach the subscriber registration method as previously discussed in Claim 9. *Morin* further teaches wherein a selection function of said data network is initiated using said information about said at least one required capability, and a resulting identification information of said new serving network

element is notified to a proxy network element connected to said terminal device **(The subscriber profile is compared to the MSC capabilities to check for compatibility via the gateway MSC 127. Column 4, Lines 35-55).**

As to **Claims 16-17 and 33**, *Morin-Clapton* teach the subscriber registration method as previously discussed in Claim 15. *Clapton* further teaches wherein said notification is performed using an identification of said proxy network element stored at a subscriber database **(VLR 125. Column 3, Lines 21-35).**

As to **Claim 41**, *Morin-Clapton* teach the subscriber registration method as previously discussed in Claim 40. *Morin* further teaches wherein sending a registration authorization message to a subscriber database in response to a registration message for a new registration of a terminal device; receiving in response to the registration authorization message a response message comprising capability information corresponding to the current serving network element; and using the capability information in the checking **(The subscriber profile is compared to the MSC capabilities to check for compatibility. Column 4, Lines 35-55).**

8. **Claims 5-8 and 19-20** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Morin* (U.S. Patent No. 6,584,312) in view of *Clapton* (U.S. Patent No. 6,556,823) and in further view of *Denenberg* (U.S. Patent No. 6,859,649).

As to **Claims 5-7**, *Morin-Clapton* teach the subscriber registration method as previously discussed in Claim 1.

However, *Morin-Clapton* do not expressly disclose wherein said checking is performed on the basis of capability information added based on said detecting a response message of a re-registration procedure initiated by said terminal device.

Denenburg, in the same field of endeavor, teaches wherein said checking step is performed on the basis of a capability information added based on said detection step to a response message of a re-registration procedure initiated by said terminal device **(*Denenburg*; In the event of subscriber information incompatibility, said terminal device is de-registered and given alternate capability information for re-registration during the activation periods. Column 5, Lines 23-42 and Column 8, Lines 19-24).**

At the time of invention it would have been obvious to a person of ordinary skill in the art to have combined the subscriber registration method as taught by *Morin-Clapton* with wherein said checking is performed on the basis of a capability information as taught by *Denenburg*. The motivation would have been to allow the terminal device to use additional subscription information features at a new serving terminal.

As to **Claims 8 and 19-20**, *Morin-Clapton* teach the subscriber registration method as previously discussed in Claim 1. *Denenburg* further teaches wherein a configuration information is provided for determining subscribed services needing

predetermined serving network elements (**Administrative Center 280 provides configuration information for terminal devices and network elements, predetermining which network elements are subscribable. Figures 2-4; Column 6, Lines 41-54 and Column 5, Lines 43-62).**

9. **Claims 38 and 39** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Morin* (U.S. Patent No. 6,584,312) in view of *Clapton* (U.S. Patent No. 6,556,823) and in further view of *Wang* (U. S. PGPub No. 2002/0131395).

As to **Claims 38 and 39**, *Morin-Clapton* discloses apparatus as previously discussed in Claim 37.

However, *Morin-Clapton* do not expressly disclose wherein said de-register message is a message in accordance with a session initiation protocol NOTIFY-message.

Wang, in the same field of endeavor, teaches sending messages over a session initiation protocol using NOTIFY-messages (**Paragraph 0038**).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to have combined sending de-register messages in the apparatus, as taught by *Morin-Clapton*, to wherein said de-registration messages are in accordance with a session initiation protocol as taught by *Wang*. The motivation would have been to use a standard protocol for communication.

10. **Claim 43** is rejected under 35 U.S.C. 103(a) as being unpatentable over *Morin* (U.S. Patent No. 6,584,312) in view of *Clapton* (U.S. Patent No. 6,556,823) and in further view of *Sanchez* (U.S. PGPub. No. 2002/0147845).

As to **Claim 43**, *Morin-Clapton* teach the apparatus as previously discussed in Claim 40.

However, *Morin-Clapton* do not expressly disclose the apparatus is an interrogating call state control function of an Internet Protocol Multimedia Subsystem.

Sanchez, in the same field of endeavor, describes using an interrogating call state control function of an Internet Protocol Multimedia Subsystem (**Paragraph 0009**).

At the time of invention, it would have been obvious to one of ordinary skill in the art to combine the apparatus as taught by *Morin-Clapton* with an interrogating call state control function as taught by *Sanchez*. The motivation would have been to use standard communication servers.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT B. MCADAMS whose telephone number is (571)270-3309. The examiner can normally be reached on Monday-Thursday 5:30am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571-272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. B. M./
Examiner, Art Unit 2456

/KEVIN BATES/
Primary Examiner, Art Unit 2456